

**ELECTRONIC FILING**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Patent No. 7,645,733 B2

Issued: January 12, 2010

Patentee Brines *et al.*

Confirmation No.: 2092

Serial No.: 10/573,905

Art Unit: 1647

International filing date: September 29, 2004

Examiner: DeBerry, Regina M.

For: TISSUE PROTECTIVE  
CYTOKINES FOR THE  
TREATMENT AND PREVENTION  
OF SEPSIS  
AND THE FORMATION OF  
ADHESIONS

Attorney Docket No.: 10165-042-999  
CAM No.: 508991-999041

**REQUEST FOR RECONSIDERATION OF  
PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The above-identified patent issued on January 12, 2010. According to the cover of the patent and the Issue Notification, the Patent Term Adjustment under 35 U.S.C. § 154(b) is 251 days.

Patentee hereby respectfully requests reconsideration of the patent term Adjustment indicated on the cover of the issued patent and in the Determination of Patent Term adjustment under 35 U.S.C. § 154(b) ("Determination") stated in the Issue Notification. Specifically, Patentee believes that the patent term adjustment of 251 days is not correct. The correct number of days for the patent term adjustment, for reasons explained below, should be, at a minimum, equal to the period starting July 31, 2007 and ending June 4, 2008 (310 days) plus the period starting March 30, 2009 and ending on January 12, 2010 (289 days), the issue date of the above-

identified patent (*see* 37 C.F.R. §§ 1.703(a)(1) and 1.703(b)), minus 59 days consumed by Applicant delay (*see* 37 C.F.R. § 1.704(b)). Therefore, Patentee believes that the patent term adjustment should be, at a minimum, a total of 540 days.

A request for reconsideration of patent term adjustment under 37 C.F.R. § 1.705(b) must be accompanied by:

- (1) the fee set forth in 37 C.F.R. § 1.18(e); and
- (2) a statement of the facts involved, specifying:
  - (i) the correct patent term adjustment and the basis or bases under 37 C.F.R. § 1.702 for the adjustment;
  - (ii) the relevant dates as specified in 37 C.F.R. §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in 37 C.F.R. § 1.703(f) to which the patent is entitled;
  - (iii) whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and
  - (iv)
    - (A) any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704; or
    - (B) that there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704.

*See* 37 C.F.R. § 1.705(b).

**1. Fee Required Under 37 C.F.R. § 1.705(b)(1)**

Pursuant to 37 C.F.R. §§ 1.705(b)(1) and § 1.18(e), the fee required for filing this request is believed to be \$200.00.

Please charge any required fees to Jones Day Deposit Account No. 50-3013.

**2. Statement Required Under 37 C.F.R. § 1.705(b)(2)**

Pursuant to 37 C.F.R. § 1.702, Patentee submits the following statement of facts in support of this request:

1. The correct patent term adjustment and the basis or bases under 37 C.F.R. § 1.702 for the adjustment are as follows:

- A. Correct patent term adjustment:

The correct patent term adjustment is 540 days, which is attributable to (a) the failure of the PTO to mail a notification under 35 U.S.C. § 132 not later than fourteen months after the date on which the application on which this patent is based, Application No. 10/573,905 (the “ ’905 application”), fulfilled the requirements of 35 U.S.C. § 371 (delay under 37 C.F.R. § 1.702(a)(1)) (the “A period”) minus the number of any actual calendar days occurring in both the A period and in the “B period” described below; and (b) the failure of the PTO to issue a patent within three years of the actual filing date (*i.e.*, the date on which the national stage commenced under 35 U.S.C. § 371(b) or (f) in an international application) of the ’905 application (delay under 37 C.F.R. § 1.702(b)) (the “B period”), and minus the time consumed by Applicant delay as provided for in 37 C.F.R. § 1.704(b).

- B. Bases under 37 C.F.R. § 1.702 for the adjustment:

- (i) Delay under 37 C.F.R. § 1.702(a) (the “A period”)

The delay by the PTO under 37 C.F.R. § 1.702(a) is 310 days.

As acknowledged by the PTO in its calculation of the patent term adjustment, the PTO failed to mail a notification under 35 U.S.C. § 132 within fourteen months from the date on which the ’905 application fulfilled the requirements of 35 U.S.C. § 371. *See* PTO’s Patent Application Information Retrieval page for U.S. Application No. 10/573,905 at Patent Term Adjustment History (“PTO PAIR Adjustment,” Exhibit A, downloaded March 11, 2010). International Patent Application No. PCT/US04/31789 was filed on September 29, 2004, commenced the national stage under 35 U.S.C. § 371 on March 29, 2006, and was assigned Application No. 10/573,905. The ’905 application was determined to fulfill the requirements of 35 U.S.C. § 371 on May 30, 2006. The first notification under 35 U.S.C. § 132 (a Restriction Requirement) was mailed by the PTO on June 4, 2008. Accordingly, the PTO did not mail a notification under 35 U.S.C. § 132 or a notice of allowance under 35 U.S.C. § 151 within fourteen months after the date on which the application fulfilled the requirements of

35 U.S.C. § 371 (*i.e.*, by July 31, 2007), and thus, the delay under 37 C.F.R. § 1.702(a)(1) includes 310 days.

In sum, the number of days of delay in the A period, that is, under subsection (a)(1) of 37 C.F.R. § 1.702 is, at a minimum, 310 days. Thus, Patentee does not contest the PTO's calculation of the A period.

(ii) Delay under 37 C.F.R. § 1.702(b) (the "B period")

The delay by the PTO under 37 C.F.R. § 1.702(b) is 289 days.

The '905 application is the national stage of International Patent Application No. PCT/US04/31789, which was filed on September 29, 2004. The national stage commenced under 35 U.S.C. § 371 on March 29, 2006. A patent based on the '905 application issued on January 12, 2010. As provided for under 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1), the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the national stage commenced under 35 U.S.C. § 371(b) or (f) in an international application. Therefore, in this case, the "B period" begins on March 30, 2009 and ends on January 12, 2010, the date that the patent issued (289 days). This delay in issuance of the patent was not calculated by the PTO in its determination of patent term adjustment (*see* "PTO PAIR Adjustment," Exhibit A). Therefore, the total patent term adjustment for delay in issuance of the patent under the B period is 289 days.

(iii) Overlapping Days in the Delay Periods

According to 35 U.S.C. § 154(b)(2)(A): "To the extent that periods of delay attributable to grounds specified in paragraph (1) *overlap*, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed." *See* 35 U.S.C. § 154(b)(2)(A).

Patentee submits that there was no overlap of the actual calendar days of the A period, discussed in detail below, with the actual calendar days of the B period. Thus, the period of patent term adjustment on a patent that issues on the above-identified patent application is calculated as the sum of 310 plus 289, which is equal to 599 days (minus the time consumed by Applicant delay as discussed in section II(B) below).

Patentee respectfully submits that under controlling case law, calculating the patent term adjustment is the result of summing the number of days of delay under 37 C.F.R. § 1.702(a) that do not comprise actual calendar days occurring in the B period (that is, the A period minus calendar days overlapping in both the A and B periods) and the number of days of delay under 37 C.F.R. § 1.702(b) (the B period). *See Wyeth v. Dudas*, 580 F.Supp.2d 138 (D.D.C. 2008), *aff'd*, *Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir. January 7, 2010) (hereinafter *Wyeth*) (see attached Exhibit B).

In *Wyeth*, the Court held that “the only way that periods of time can ‘overlap’ is if they occur on the same day [and thus, if] an ‘A delay’ occurs on one calendar day and a ‘B delay’ occurs on another, they do not overlap.”

Turning to the '905 application, the period of delay under subsection (a)(1) of 37 C.F.R. § 1.702 includes the days of July 31, 2007 to June 4, 2008 (310 days). The delay under 37 C.F.R. § 1.702(b) comprises March 30, 2009 to January 12, 2010, the day on which the patent issued (289 days). Thus, the delay under 37 C.F.R. § 1.702(a)(1) occurring from July 31, 2007 to June 4, 2008 occurred on different calendar days than the delay under 37 C.F.R. § 1.702(b) (March 30, 2009 to January 12, 2010). Consequently, under 35 U.S.C. § 154(b)(2)(A), the 310 days under 37 C.F.R. § 1.702(a) do not overlap the 289 days of delay under 37 C.F.R. § 1.702(b) for the '905 application, and therefore the total delay under 37 C.F.R. § 1.702 for the calculated patent term adjustment should be a summation of all delays under 37 C.F.R. § 1.702(a) and 37 C.F.R. § 1.702(b), or **399** days (the sum of 310 and 289 days).

II. The relevant dates as specified in 37 C.F.R. §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in 37 C.F.R. § 1.703(f) and 37 C.F.R. § 1.704(b) are as follows:

A. Adjustment under 37 C.F.R. §§ 1.703(a) through (e):

An adjustment is sought under 37 C.F.R. § 1.703(a)(1), which provides, in relevant part, that the period of adjustment is “[t]he number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151.

whichever occurs first.” In particular, Patentee seeks to include the delay under 37 C.F.R. § 1.702(a)(1) occurring from July 31, 2007 to June 4, 2008 (310 days) that occurred on different calendar days than the delay under 37 C.F.R. § 1.702(b).

An adjustment is sought under 37 C.F.R. § 1.703(b), which provides that “the period of adjustment under 37 C.F.R. § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued.” Patentee submits that this period consists of 289 days for the period beginning the day after March 29, 2009 (the date that is three years after the date on which the national stage commenced under 35 U.S.C. 371(f)) and ending on the day that the patent issued, January 12, 2010.

Patentee further submits that the 310 actual calendar days of delay under 37 C.F.R. § 1.702(a) do not overlap the any of the 289 actual calendar days of delay under 37 C.F.R. § 1.702(b), as explained above.

Accordingly, Patentee believes that the delays attributable to PTO delay under 37 C.F.R. § 1.702 total 599 days.

B. Adjustment under 37 C.F.R. § 1.704(b):

As discussed in section II(A) *supra*, Patentee believes that the total delay by the PTO under 37 C.F.R. § 1.702(a) and (b) amounts to 599 days.

In the PTO PAIR Adjustment, the PTO has determined the Applicant delay to be a period of 59 days. Patentee accepts this determination, and thus believes that the delay attributable to Applicants under 37 C.F.R. § 1.704(b) is 59 days.

Therefore, Patentee believes that the total period of adjustment due under 37 C.F.R. § 1.703(f) is 599 days minus 59 days, *i.e.*, 540 days, not the 251 days calculated by the PTO. This total period is the sum of the periods of delay by the PTO calculated under 37 C.F.R. §§ 1.702(a) through (e) (*i.e.*, 310 days plus 289 days), less the sum of the period calculated under Section 1.704(b) (*i.e.*, 59 days).

III. The '905 application is not subject to a terminal disclaimer.

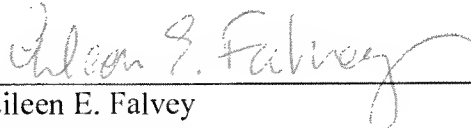
IV. Aside from the circumstances described in section 11(B) *supra*, Patentee believes that there were no other circumstances under 37 C.F.R. § 1.704 constituting a failure by Applicants to engage in reasonable efforts to conclude processing or examination of the '905 application.

In summary, the total adjustment under 37 C.F.R. § 1.702(a) and (b) is 599 days, the total delay attributable to Applicants under 37 C.F.R. § 1.704 is 59 days, and thus the total period of adjustment due under 37 C.F.R. § 1.703(f) is believed to be 540 days. Accordingly, Patentee respectfully requests an adjustment of patent term under 37 C.F.R. § 1.703(f) totaling 540 days.

Patentee submits that the issues raised in this request for reconsideration of patent term adjustment are timely raised. In particular, this request is in compliance with 37 C.F.R. § 1.705(b) and 37 C.F.R. § 1.705(d), the latter of which provides in relevant part, that “[i]f there is a revision to the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment . . . [and] any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued . . . .” Since the date two months from the January 12, 2010 issue date is March 12, 2010, this request for reconsideration of patent term adjustment is timely filed.

Respectfully submitted,

Date: March 12, 2010

  
Eileen E. Falvey 46,097  
**JONES DAY** (Reg. No.)  
222 East 41st Street  
New York, New York 10017  
(212) 326-3939

Enclosures

**EXHIBIT A:**  
**PTO PAIR Adjustment**



|            |   |                      |
|------------|---|----------------------|
| 10/573,905 | TISSUE PROTECTIVE CYTOKINES FOR THE TREATMENT AND PREVENTION OF SEPSIS AND THE FORMATION OF ADHESIONS | 03-11-2010::18:17:50 |
|------------|---|----------------------|









### Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/573,905

|                              |            |                                      |     |
|------------------------------|------------|--------------------------------------|-----|
| Filing or 371(c) Date:       | 05-30-2006 | USPTO Delay (PTO) Delay (days):      | -   |
| Issue Date of Patent:        | 01-12-2010 | Three Years:                         | -   |
| Pre-Issue Petitions (days):  | -          | Applicant Delay (APPL) Delay (days): | -   |
| Post-Issue Petitions (days): | -          | Total PTA (days):                    | 251 |
| USPTO Adjustment(days):      | -          | Explanation Of Calculations          |     |

### Patent Term Adjustment History

| Date       | Contents Description   | PTO(Days) | APPL(Days) |
|------------|--|-----------|------------|
| 12-23-2009 | PTA 36 Months  |           |            |
| 01-12-2010 | Patent Issue Date Used in PTA Calculation  |           |            |
| 11-30-2009 | Dispatch to FDC  |           |            |
| 11-30-2009 | Correspondence Address Change  |           |            |
| 11-25-2009 | Application Is Considered Ready for Issue  |           |            |
| 11-20-2009 | Applicant Has Filed a Verified Statement of Small Entity Status in Compliance with 37 CFR 1.27 |           |            |
| 11-20-2009 | Issue Fee Payment Verified   |           |            |
| 11-20-2009 | Issue Fee Payment Received   |           |            |
| 08-21-2009 | Mail Notice of Allowance   |           |            |
| 08-20-2009 | Document Verification  |           |            |
| 08-20-2009 | Notice of Allowance Data Verification Completed  |           |            |
| 08-20-2009 | Case Docketed to Examiner in GAU   |           |            |
| 07-29-2008 | Reference capture on IDS   |           |            |
| 07-29-2008 | Information Disclosure Statement (IDS) Filed   |           |            |
| 08-20-2009 | Examiner's Amendment Communication   |           |            |
| 06-10-2009 | Date Forwarded to Examiner   |           |            |
| 04-24-2009 | Response after Non-Final Action  |           | 59         |
| 04-24-2009 | Request for Extension of Time - Granted  |           | ⬆          |
| 11-24-2008 | Mail Non-Final Rejection   |           | ⬆          |
| 11-24-2008 | Mail Examiner Interview Summary (PTOL - 413)   |           |            |
| 11-21-2008 | Non-Final Rejection  |           |            |
| 11-19-2008 | Examiner Interview Summary Record (PTOL - 413)   |           |            |
| 07-29-2008 | Information Disclosure Statement considered  |           |            |
| 09-10-2008 | Date Forwarded to Examiner   |           |            |
| 08-04-2008 | Response to Election / Restriction Filed   |           |            |
| 08-04-2008 | Request for Extension of Time - Granted  |           |            |
| 07-29-2008 | Information Disclosure Statement (IDS) Filed   |           |            |
| 06-04-2008 | Mail Restriction Requirement   | 310       |            |
| 06-03-2008 | Requirement for Restriction / Election   | ⬆         |            |
| 01-10-2008 | Preliminary Amendment  | ⬆         |            |

|            |  |   |
|------------|--|---|
| 11-13-2007 | Preliminary Amendment                              |  |
| 11-19-2007 | Filing Receipt - Corrected                         |  |
| 06-07-2007 | PG-Pub Issue Notification                          |  |
| 04-26-2007 | IFW TSS Processing by Tech Center Complete         |  |
| 04-05-2007 | Case Docketed to Examiner in GAU                   |  |
| 05-30-2006 | Oath or Declaration Filed (Including Supplemental) |  |
| 03-16-2007 | Application Dispatched from OIPE                   |  |
| 05-30-2006 | 371 Completion Date                                |  |
| 03-13-2007 | Sent to Classification Contractor                  |   |
| 03-13-2007 | Notice of DO/EO Acceptance Mailed                  |   |

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Close Window

**EXHIBIT B:**

**Copies of *Wyeth v. Dudas* and *Wyeth v. Kappos***

cent of his annual workload. *Id.* at 15:12–16. Moreover, according to Geiseler, the need to review proposed legislation and FDIC regulations, tasks that had also been performed by the plaintiff, had diminished. *Id.* at 16:14–17:22.

In the final analysis, the Court is not persuaded that the plaintiff has provided sufficient evidence to persuade a reasonable jury that “the defendant intentionally discriminated against [her]. . . .” *Burdine*, 450 U.S. at 253, 101 S.Ct. 1089. Accordingly, the defendant is entitled to summary judgment on the plaintiff’s Title VII race discrimination claim.

#### IV. Conclusion

For the foregoing reasons, the Court concludes that the plaintiff has failed to show that the defendant’s legitimate, non-discriminatory reason for her reassignment was a pretext for discrimination and therefore the defendant’s motion for summary judgment must be granted.

**SO ORDERED** on this 30th day of September, 2008.<sup>10</sup>



WYETH, et al., Plaintiffs,

v.

Jon W. DUDAS, Under Secretary of  
Commerce for Intellectual Property  
and Director of U.S. Patent and  
Trademark Office, Defendant.

Civil Action No. 07–1492 (JR).

United States District Court,  
District of Columbia.

Sept. 30, 2008.

**Background:** Patent owners brought action challenging method used by Patent

and Trademark Office (PTO) to calculate extensions of patent terms for certain specified kinds of PTO delay.

**Holding:** The District Court, James Robertson, J., held that extension of patent term based on PTO delay could exceed three years.

Ordered accordingly.

#### 1. Patents ⇌ 133

Patent and Trademark Office’s (PTO) interpretation of statute providing extensions of patent terms for certain specified kinds of PTO delay was not entitled to *Chevron* deference. 35 U.S.C.A. § 154(b)(2)(C)(iii), (b)(3)(A).

#### 2. Patents ⇌ 133

Extension of patent term for any administrative delay by Patent and Trademark Office (PTO) in issuing patent more than three years after filing date did not necessarily overlap with extensions provided as result of PTO’s failure to comply with enumerated statutory deadlines, and thus statutory prohibition against double-counting did not preclude patent applicants from claiming extensions in excess of three years. 35 U.S.C.A. § 154(b).

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David O. Bickart, Kaye Scholer LLP,  
Washington, DC, Patricia A. Carson, Kaye  
Scholer LLP, New York, NY, for Plain-  
tiffs.

Fred Elmore Haynes, U.S. Attorney’s  
Office, Washington, DC, for Defendant.

opinion.

<sup>10</sup> An Order consistent with this Court’s ruling is being issued simultaneously with this

**MEMORANDUM OPINION**

JAMES ROBERTSON, District Judge.

Plaintiffs here take issue with the interpretation that the United States Patent and Trademark Office (PTO) has imposed upon 35 U.S.C. § 154, the statute that prescribes patent terms. Section 154(a)(2) establishes a term of 20 years from the day on which a successful patent application is first filed. Because the clock begins to run on this filing date, and not on the day the patent is actually granted, some of the effective term of a patent is consumed by the time it takes to prosecute the application. To mitigate the damage that bureaucracy can do to inventors, the statute grants extensions of patent terms for certain specified kinds of PTO delay, 35 U.S.C. § 154(b)(1)(A), and, regardless of the reason, whenever the patent prosecution takes more than three years. 35 U.S.C. § 154(b)(1)(B). Recognizing that the protection provided by these separate guarantees might overlap, Congress has forbidden double-counting: “To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.” 35 U.S.C. § 154(b)(2)(A). Plaintiffs claim that the PTO has misconstrued or misapplied this provision, and that the PTO is denying them a portion of the term Congress has provided for the protection of their intellectual property rights.

**Statutory Scheme**

Until 1994, patent terms were 17 years from the date of issuance. *See* 35 U.S.C. § 154 (1992) (“Every patent shall contain . . . a grant . . . for the term of seventeen years . . . of the right to exclude others

from making, using, or selling the invention throughout the United States. . . .”). In 1994, in order to comply with treaty obligations under the General Agreement on Tariffs and Trade (GATT), the statute was amended to provide a 20-year term from the date on which the application is first filed. *See* Pub.L. No. 103-465, § 532, 108 Stat. 4809, 4984 (1994). In 1999, concerned that extended prosecution delays could deny inventors substantial portions of their effective patent terms under the new regime, Congress enacted the American Inventors Protection Act, a portion of which—referred to as the Patent Term Guarantee Act of 1999—provided for the adjustments that are at issue in this case. Pub.L. No. 106-113, §§ 4401-4402, 113 Stat. 1501, 1501A-557 (1999).

As currently codified, 35 U.S.C. § 154(b) provides three guarantees of patent term, two of which are at issue here. The first is found in subsection (b)(1)(A), the “[g]uarantee of prompt Patent and Trademark Office response.” It provides a one-day extension of patent term for every day that issuance of a patent is delayed by a failure of the PTO to comply with various enumerated statutory deadlines: fourteen months for a first office action; four months to respond to a reply; four months to issue a patent after the fee is paid; and the like. *See* 35 U.S.C. § 154(b)(1)(A)(i)-(iv). Periods of delay that fit under this provision are called “A delays” or “A periods.” The second provision is the “[g]uarantee of no more than 3-year application pendency.” Under this provision, a one-day term extension is granted for every day greater than three years after the filing date that it takes for the patent to issue, regardless of whether the delay is the fault of the PTO.<sup>1</sup> *See* 35 U.S.C.

1. Certain reasons for exceeding the three-year pendency period are excluded, *see* 35 U.S.C.

§ 154(b)(1)(b)(i)-(iii), as are periods attribut-

§ 154(b)(1)(B). The period that begins after the three-year window has closed is referred to as the “B delay” or the “B period”. (“C delays,” delays resulting from interferences, secrecy orders, and appeals, are similarly treated but were not involved in the patent applications underlying this suit.)

The extensions granted for A, B, and C delays are subject to the following limitation:

**(A) In general.**—To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

35 U.S.C. § 154(b)(2)(A). This provision is manifestly intended to prevent double-counting of periods of delay, but understanding that intent does not answer the question of what is double-counting and what is not. Proper interpretation of this proscription against windfall extensions requires an assessment of what it means for “periods of delay” to “overlap.”

The PTO, pursuant to its power under 35 U.S.C. § 154(b)(3)(A) to “prescribe regulations establishing procedures for the application for and determination of patent term adjustments,” has issued final rules and an “explanation” of the rules, setting forth its authoritative construction of the double-counting provision. The rules that the PTO has promulgated essentially parrot the statutory text, *see* 37 C.F.R. § 1.703(f), and so the real interpretive act is found in something the PTO calls its Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. § 154(b)(2)(A), which was published on

June 21, 2004, at 69 Fed.Reg. 34238. Here, the PTO “explained” that:

the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B), *the entire period during which the application was pending before the Office* (except for periods excluded under 35 U.S.C. § 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, *is the relevant period under 35 U.S.C. § 154(b)(1)(B) in determining whether periods of delay “overlap” under 35 U.S.C. 154(b)(2)(A).*

69 Fed.Reg. 34238 (2004) (emphasis added). In short, the PTO’s view is that any administrative delay under § 154(b)(1)(A) overlaps any 3-year maximum pendency delay under § 154(b)(1)(B): the applicant gets credit for “A delay” or for “B delay,” whichever is larger, but never A + B.

In the plaintiffs’ submission, this interpretation does not square with the language of the statute. They argue that the “A period” and “B period” overlap only if they occur on the same calendar day or days. Consider this example, proffered by plaintiff: A patent application is filed on 1/1/02. The patent issues on 1/1/08, six years later. In that six-year period are two “A periods,” each one year long: (1) the 14-month deadline for first office action is 3/1/03, but the first office action does not occur until 3/1/04, one year late; (2) the 4-month deadline for patent issuance after payment of the issuance fee is 1/1/07, but the patent does not issue until 1/1/08, another year of delay attributable to the PTO. According to plaintiff, the “B period” begins running on 1/1/05, three years after the patent application was filed, and ends three years later, with the issuance of the patent on 1/1/08. In this

able to the applicant’s own delay. *See* 35

U.S.C. § 154(b)(2)(C).

example, then, the first “A period” does not overlap the “B period,” because it occurs in 2003–04, not in 2005–07. The second “A period,” which covers 365 of the same days covered by the “B period,” does overlap. Thus, in plaintiff’s submission, this patent holder is entitled to four years of adjustment (one year of “A period” delay + three years of “B period” delay). But in the PTO’s view, since “the entire period during which the application was pending before the office” is considered to be “B period” for purposes of identifying “overlap,” the patent holder gets only three years of adjustment.

#### **Chevron Deference**

We must first decide whether the PTO’s interpretation is entitled to deference under *Chevron v. NRDC*, 467 U.S. 837, 104 S.Ct. 2778, 81 L.Ed.2d 694 (1984). No, the plaintiffs argue, because, under the Supreme Court’s holdings in *Gonzales v. Oregon*, 546 U.S. 243, 126 S.Ct. 904, 163 L.Ed.2d 748 (2006), and *United States v. Mead Corp.*, 533 U.S. 218, 121 S.Ct. 2164, 150 L.Ed.2d 292 (2001), Congress has not “delegated authority to the agency generally to make rules carrying the force of law,” and in any case the interpretation at issue here was not promulgated pursuant to any such authority. See *Gonzales*, 546 U.S. at 255–56, 126 S.Ct. 904, citing *Mead*, 533 U.S. at 226–27, 121 S.Ct. 2164. Since at least 1996, the Federal Circuit has held that the PTO is not afforded *Chevron* deference because it does not have the authority to issue substantive rules, only procedural regulations regarding the conduct of proceedings before the agency. See *Merck & Co. v. Kessler*, 80 F.3d 1543, 1549–50 (Fed.Cir.1996).

[1] Here, as in *Merck*, the authority of the PTO is limited to prescribing “regulations establishing *procedures* for the application for and determination of patent term adjustments under this subsection.”

35 U.S.C. § 154(b)(3)(A) (emphasis added). Indeed, a comparison of this rulemaking authority with the authority conferred for a different purpose in the immediately preceding section of the statute makes it clear that the PTO’s authority to interpret the overlap provision is quite limited. In 35 U.S.C. § 154(b)(2)(C)(iii) the PTO is given the power to “prescribe regulations establishing the *circumstances that constitute* a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application” (emphasis added)—that is, the power to elaborate on the meaning of a particular statutory term. No such power is granted under § 154(b)(3)(A). *Chevron* deference does not apply to the interpretation at issue here.

#### **Statutory Construction**

*Chevron* would not save the PTO’s interpretation, however, because it cannot be reconciled with the plain text of the statute. If the statutory text is not ambiguous enough to permit the construction that the agency urges, that construction fails at *Chevron*’s “step one,” without regard to whether it is a reasonable attempt to reach a result that Congress might have intended. See, e.g., *MCI v. AT & T*, 512 U.S. 218, 229, 114 S.Ct. 2223, 129 L.Ed.2d 182 (1994) (“[A]n agency’s interpretation of a statute is not entitled to deference when it goes beyond the meaning that the statute can bear.”).

The operative question under 35 U.S.C. § 154(b)(2)(A) is whether “periods of delay attributable to grounds specified in paragraph (1) overlap.” The only way that periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another, they do not overlap, and § 154(b)(2)(A) does not limit the extension to one day. Recognizing this,

the PTO defends its interpretation as essentially running the “period of delay” under subsection (B) from the filing date of the patent application, such that a period of “B delay” *always overlaps* with any periods of “A delay” for the purposes of applying § 154(b)(2)(A).

[2] The problem with the PTO’s construction is that it considers the application *delayed* under § 154(b)(1)(B) during the period *before it has been delayed*. That construction cannot be squared with the language of § 154(b)(1)(B), which applies “if the issue of an original patent is *delayed* due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.” (Emphasis added.) “B delay” begins when the PTO has failed to issue a patent within three years, not before.

The PTO’s interpretation appears to be driven by Congress’s admonition that any term extension “not exceed the actual number of days the issuance of the patent was delayed,” and by the PTO’s view that “A delays” during the first three years of an applications’ pendency inevitably lead to “B delays” in later years. Thus, as the PTO sees it, if plaintiffs’ construction is adopted, one cause of delay will be counted twice: once because the PTO has failed to meet an administrative deadline, and again because that failure has pushed back the entire processing of the application into the “B period.” Indeed, in the example set forth above, plaintiffs’ calendar-day construction does result in a total effective patent term of 18 years under the (B) guarantee, so that—again from the PTO’s viewpoint—the applicant is not “compensated” for the PTO’s administrative delay, he is benefitted by it.

But if subsection (B) had been intended to guarantee a 17-year patent term and *no more*, it could easily have been written that way. It is true that the legislative

context—as distinct from the legislative history—suggests that Congress may have intended to use subsection (B) to guarantee the 17-year term provided before GATT. But it chose to write a “[g]uarantee of no more than 3-year application pendency,” 35 U.S.C. § 154(b)(1)(B), not merely a guarantee of 17 effective years of patent term, and do so using language separating that guarantee from a different promise of prompt administration in subsection (A). The PTO’s efforts to prevent windfall extensions may be reasonable—they may even be consistent with Congress’s intent—but its interpretation must square with Congress’s words. If the outcome commanded by that text is an unintended result, the problem is for Congress to remedy, not the agency.



Norman A. THOMAS, Plaintiff,

v.

DISTRICT OF COLUMBIA  
GOVERNMENT, et al.,  
Defendants.

Civil Action No. 07-1286(HHK).

United States District Court,  
District of Columbia.

Sept. 30, 2008.

**Background:** Alien brought action seeking to have records of time he spent in state and District of Columbia custody corrected in order to be in better position to avoid order of removal. District and Department of Homeland Security moved to dismiss.



# United States Court of Appeals for the Federal Circuit

2009-1120

WYETH  
and ELAN PHARMA INTERNATIONAL LIMITED,

Plaintiffs-Appellees,

v.

David J. Kappos, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL  
PROPERTY and DIRECTOR OF THE UNITED STATES PATENT  
AND TRADEMARK OFFICE,

Defendant-Appellant.

Patricia A. Carson, Kaye Scholer LLP, of New York, New York, argued for plaintiffs-appellees. With her on the brief were Richard G. Greco; and David O. Bickart, of Washington, DC. Of counsel were Thomas E. Malone, Elan Pharmaceuticals, of South San Francisco, California; and Reem F. Jishi, Wyeth, of Madison, New Jersey.

Christine N. Kohl, Attorney, Appellate Staff, Civil Division, United States Department of Justice, of Washington, DC, argued for defendant-appellant. On the brief were Tony West, Assistant Attorney General, Channing D. Phillips, Acting United States Attorney, and Scott R. McIntosh and Abby C. Wright, Attorneys. Of counsel on the brief were James A. Toupin, General Counsel, and Raymond T. Chen, Deputy General Counsel and Solicitor, United States Patent and Trademark Office, of Arlington, Virginia.

William G. James, II, Kenyon & Kenyon LLP, of Washington, DC, for amicus curiae Hospira, Inc. With him on the brief was Richard W. Ward.

Jeffrey B. Elikan, Covington & Burling LLP, of Washington, DC, for amicus curiae Pharmaceutical Research and Manufacturers of America, et al. With him on the brief were E. Edward Bruce and James P. Sullivan.

Appealed from: United States District Court for the District of Columbia

Judge James Robertson

# United States Court of Appeals for the Federal Circuit

2009-1120

WYETH  
and ELAN PHARMA INTERNATIONAL LIMITED,

Plaintiffs-Appellees,

v.

David J. Kappos, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL  
PROPERTY and DIRECTOR OF THE UNITED STATES PATENT  
AND TRADEMARK OFFICE,

Defendant-Appellant.

Appeal from the United States District Court for the District of Columbia in case no. 07-CV-1492, Judge James Robertson.

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DECIDED: January 7, 2010

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Before RADER, PLAGER, and MOORE, Circuit Judges.

RADER, Circuit Judge.

I.

On summary judgment, the United States District Court for the District of Columbia held that plaintiffs Wyeth and Elan Pharma International Ltd. (collectively, “Wyeth”) were entitled to extended patent term adjustments under 35 U.S.C. § 154(b) due to the Patent and Trademark Office’s (the “PTO’s”) delay in prosecuting their patent applications. Because section 154(b) expressly permits this legal relief, this court affirms.

## II.

In 1994, the law changed the effective term of a patent from seventeen years commencing from issuance to twenty years from filing. See Pub. L. No. 103-465, § 532, 108 Stat. 4809, 4984 (1994). With the change came new ways of compensating patentees for PTO-caused delays during prosecution. Under the previous seventeen-year regime, PTO-caused delays could not affect patent terms because the term commenced upon issuance after any delays during patent acquisition. Under the twenty-year term, however, those delays consumed the effective term of a patent.

In 1999, the American Inventors Protection Act amended 35 U.S.C. § 154(b) to address this new problem. The new Act promised patent applicants a full patent term adjustment for any delay during prosecution caused by the PTO. This promise took the form of three distinct “guarantees” in 35 U.S.C. § 154(b)(1):

(A) Guarantee of prompt Patent and Trademark Office responses.--Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to [meet deadlines specified in clauses (i)-(iv)] . . .

the term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken.

(B) Guarantee of no more than 3-year application pendency.--Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States . . .

the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

(C) Guarantee or adjustments for delays due to interferences, secrecy orders, and appeals.--Subject to the limitations under paragraph (2) . . .  
the term of the patent shall be extended 1 day for each day of the pendency of the proceeding, order, or review, as the case may be.

(emphases added). To summarize, paragraph A (the “A guarantee” or “A clause”) promises “prompt [PTO] responses” by extending the term of the patent one day for each day the PTO does not meet certain examination deadlines in subdivisions (i)-(iv). Id. § 154(b)(1)(A). One of these deadlines, for instance, requires a first response to a filed application within fourteen months. See id. § 154(b)(1)(A)(i). Paragraph B (the “B guarantee” or “B clause”) extends the term of the patent one day for each day issuance is delayed due to the PTO’s failure “to issue a patent within 3 years after the actual filing date of the application in the United States.” Id. § 154(b)(1)(B). Last, paragraph C allows for adjustments relating to delays resulting from interference proceedings, secrecy orders, and appeals. Id. § 154(b)(1)(C). At issue in this case are the A and B guarantees.

Both the A and B clauses are expressly subject to paragraph 2’s “In general” limitation:

In general. To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Id. § 154(b)(2)(A) (emphasis added). In other words, this limitation restricts the period of adjustment when any of the “periods of delay” “overlap.” This case asks this court to interpret and enforce the guarantees in the face of an “overlap” and “periods of delay” under section 154(b)(2)(A).

Section 154(b)(3) of the statute directs the PTO to “prescribe regulations establishing procedures for the application for and determination of patent term adjustments under this subsection.” Id. § 154(b)(3) (emphasis added). Under the guise

of that authority, the PTO promulgated 37 C.F.R. § 1.703(f) in 2000: “To the extent that periods of adjustment attributable to the [guarantees] overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.” (emphasis added). Other than adding the term “periods of adjustment,” this language repeated the text of section 154(b)(2)(A). The regulations later defined “periods of adjustment” as “the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed . . . .” 37 C.F.R. § 1.703(b) (2000). The regulation supplied no explanation about implementation or application of these rules.

In 2004, the PTO amended the regulation to replace “periods of adjustment” with “periods of delay.” 69 Fed. Reg. 21706 (2004). The PTO contended that this substitution clarified the regulation:

The language of former § 1.703(f) misled applicants into believing that [periods of A-delay] and [periods of B-delay] were overlapping only if the [period of A-delay] occurred more than three years after the actual filing date of the application. If an application is entitled to a [B-]adjustment . . . the entire period during which the application was pending before the [PTO] . . . , and not just the period beginning three years after the actual filing date of the application; is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A).

Id. (emphasis added). Thus, the “period of delay,” according to the PTO’s new definition, caused the B guarantee to start with the filing of the application, not three years later. Under that interpretation, “overlap” between A adjustments and B adjustments can arise and begin during the pendency of the patent application. For example, if a patent entitled to twenty days of A adjustments issues twenty days after the three year mark, then it is only entitled to a total of twenty days of adjustment. In

other words, the entire period of A delay “overlaps” with the entire period of B delay. Using this framework, the PTO uses either the greater of the A delay or B delay to determine the appropriate adjustment but never combines the two.

Wyeth and Elan Pharma are the owners of U.S. Patent Nos. 7,179,892 (the “’892 patent”) and 7,189,819 (the “’819 patent”)—inventions that treat Alzheimer’s disease. During the prosecution of each of their respective applications, the PTO undisputedly caused delays that gave the applicants entitlement to both A and B guarantees.

For the ’892 patent, the PTO calculated 610 days of A delay and 345 days of B delay. Of the 610 days of A delay, 51 occurred more than three years after the application was filed. During the prosecution, the applicant caused 148 days of delay. Thus, under section 154(b)(2)(C), any adjustment must be reduced by that amount. See 35 U.S.C. 154(b)(2)(C). Under its greater-of-A-or-B rubric, the PTO calculated the total adjustment at 462 days—i.e., 610 (the greater of A or B) - 148 (applicant delay). According to Wyeth, however, the “period of delay” for purposes of the B clause could not have started until three years after the application’s filing date. For that reason, the only possible “overlap” was any A delay occurring after the three-year mark. Because only 51 days of A delay occurred after the three year mark for the ’892 patent, the adjustment, according to Wyeth, should have been 756 days—i.e., 610 (A delay) + 345 (B delay) - 51 (“overlap”) - 148 (applicant delay).

For the ’819 patent, the PTO calculated 336 days of A delay and 827 days of B delay. Of the 336 days of A delay, 106 occurred after the three-year mark. In this case, the applicant caused 335 days of delay. The greater-of-A-or-B rubric yields an adjustment period of 492 days—i.e., 827 (the greater of A or B) - 335 (applicant delay).

Wyeth contends the adjustment period should have been 722 days—i.e., 336 (A delay) + 827 (B delay) - 106 (“overlap”) - 335 (applicant delay).

After filing petitions for reconsideration of the adjustments with the PTO, Wyeth filed the instant action in the District Court for the District of Columbia seeking an order directing the PTO to grant an adjustment per Wyeth’s interpretation. Both parties filed motions for summary judgment. Citing section 154(b)(3) as evidence of a delegation of authority to draft regulations, the PTO sought Chevron deference for its interpretation. See Chevron U.S.A., Inc. v. Natural Resources Def. Council, Inc., 467 U.S. 837 (1984).

The district court sided with Wyeth, finding first that the PTO “does not have the authority to issue substantive rules, only procedural regulations regarding the conduct of proceedings before the agency.” Wyeth v. Dudas, 580 F. Supp. 2d 138, 141 (D.D.C. 2008) (citing Merck & Co. v. Kessler, 80 F.3d 1543, 1549-50 (Fed. Cir. 1996)). The district court further found that even if Chevron was applicable, it would have rejected the PTO’s interpretation as contrary to the plain language of the statute. As the district court put it: “The problem with the PTO’s interpretation is that it considers the application delayed under [the B guarantee] during the period before it has been delayed.” Id. at 142 (emphasis in original).

### III.

This court reviews a grant of summary judgment without deference. Johns Hopkins Univ. v. CellPro, Inc., 152 F.3d 1342, 1353 (Fed. Cir. 1998). Summary judgment is only appropriate if the court determines that there “is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.” Fed. R. Civ. P. 56(c). Because both parties in the instant case perceive no genuine

issues of material fact, this court need only decide the question of law decided by the district court. “That question is one of statutory interpretation, one that an appellate court can independently determine without deference to the trial court's interpretation.” Glaxo Operations UK Limited v. Quigg, 894 F.2d 392, 395 (Fed. Cir. 1990) (citing Madison Galleries, Ltd. v. United States, 870 F.2d 627, 629 (Fed. Cir. 1989)).

“As always, the ‘starting point in every case involving construction of a statute is the language itself.’” United States v. Hohri, 482 U.S. 64, 68 (1987) (quoting Kelly v. Robinson, 479 U.S. 36, 43 (1986)). When the terms of a statute are unambiguous, “judicial inquiry is complete, except ‘in rare and exceptional circumstances.’” Rubin v. United States, 449 U.S. 424, 430 (1981) (quoting TVA v. Hill, 437 U.S. 153, 187 n.33 (1978)). “Absent a clearly expressed legislative intention to the contrary, [the statute’s plain] language must ordinarily be regarded as conclusive.” Consumer Prod. Safety Comm’n v. GTE Sylvania, Inc., 447 U.S. 102, 108 (1980).

This court detects no ambiguity in the terms “periods of delay” and “overlap.” Each term has an evident meaning within the context of section 154(b). The limitation in section 154(b) only arises when “periods of delay” resulting from violations of the three guarantees “overlap.” 35 U.S.C. § 154(b)(2)(A). Significantly, the A and B guarantees expressly designate when and for what period they each respectively apply. Thus, this court can easily detect any overlap by examining the delay periods covered by the A and B guarantees.

A violation of the A guarantee—delays in meeting examination deadlines—begins with a “failure of the [PTO]” to meet one of the deadlines specified in subparagraphs (i)–(iv). Id. § 154(b)(1)(A). It ends when “the action described . . . is



taken.” Id. The “period of delay” for purposes of the A clause therefore runs from the date the PTO misses the specified deadline to the date (past the deadline) of response to the underlying action.

Correspondingly, a violation of the B guarantee—the one at the heart of the issue in this case—begins when the PTO fails “to issue a patent within 3 years after the actual filing date of the application in the United States . . . .” Id. § 154(b)(1)(B). It ends when “the patent is issued.” Id. The “period of delay” under the express language of the B clause therefore runs from the three-year mark after filing until the application issues.

Reading this framework into section 154(b)’s limitation provision makes it clear that no “overlap” happens unless the violations occur at the same time. Each “period of delay” has its own discrete time span whose boundaries are defined in section 154(b)(1). That is, each has a start and an end. Before the three-year mark, no “overlap” can transpire between the A delay and the B delay because the B delay has yet to begin or take any effect. If an A delay occurs on one day and a B delay occurs on a different day, those two days do not “overlap” under section 154(b)(2).

Under the PTO’s strained interpretation, B delay can occur anytime after the application is filed. To the contrary, the language of section 154(b) does not even permit B delay to start running until three years after the application is filed. The PTO’s position cannot be reconciled with the language of the statute. Thus, returning to the district court’s decision, this time with affirming approval: “The problem with the PTO’s interpretation is that it considers the application delayed under [the B guarantee] during the period before it has delayed.” Wyeth, 580 F. Supp. 2d at 142 (emphasis in original).

The PTO defends its interpretation by arguing that A delays during the first three years of prosecution ultimately lead to B delays after the three-year mark from filing. Put differently, it would be double counting if A and B delays were both used to adjust because A delays “cause” B delays. In that vein, the PTO highlights various scenarios where a hypothetical patentee appears to receive some type of windfall adjustment under the statute despite being in a similar position as other applicants who receive no similar adjustment. Indeed, the statute requires as much. Nonetheless, this court perceives potential perverse results as well under the PTO’s suggested interpretations. Under certain scenarios, both the PTO’s interpretation and the statute itself result in some imbalanced treatment of similarly-situated patentees.

For example, the language of section 154(b) presents a slight imbalance in the following hypothetical: suppose Applicant 1 receives a patent 3 years and 30 days after filing an application. In prosecuting the application, Applicant 1 incurred 30 days of A delay before the three-year mark. In the same hypothetical situation, suppose Applicant 2 also receives a patent 3 years and 30 days after filing an application but incurred no A delay during prosecution. Notably, both patents issued the same amount of time from filing—3 years and 30 days. Nonetheless, Applicant 1 would receive a 60 day adjustment whereas Applicant 2 would only receive a 30 day adjustment meaning Applicant 1’s effective term would be 30 days longer than Applicant 2.

By the same token, under the PTO’s counter-statutory interpretation, suppose Applicant 1 incurs 400 days of A delay before the three-year mark with the application issuing exactly three years after filing. Suppose Applicant 2 also incurs 400 days of A delay before the three-year mark, but in addition incurs a one-year delay by the PTO

after the three-year mark. Despite the fact each applicant incurred the same A delay, under the PTO's interpretation, Applicant 1's effective term would be a full year greater than Applicant 2's effective term. Simply put, the additional B delay incurred by Applicant 2 produces a shorter effective term.

Regardless of the potential of the statute to produce slightly different consequences for applicants in similar situations, this court does not take upon itself the role of correcting all statutory inequities, even if it could. In the end, the law has put a policy in effect that this court must enforce, not criticize or correct. See Harbison v. Bell, 129 S. Ct. 1481, 1493-94 (2009) (Thomas, J., concurring) (quoting Eldred v. Ashcroft, 537 U.S. 186, 222 (2003) ("Even if the proper interpretation of a statute upholds a 'very bad policy,' it 'is not within our province to second-guess' the 'wisdom of Congress' action' by picking and choosing our preferred interpretation from among a range of potentially plausible, but likely inaccurate, interpretations of a statute.")).

The PTO also passingly refers to the second clause of section 154(b)(2)(A) for support: "the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed." 35 U.S.C. § 154(b)(2)(A). While the PTO's argument on this point is unclear, that language does not provide any support for its interpretation. Significantly, the second clause of section 154(b)(2)(A) only takes effect upon satisfaction of the first clause. See id. § 154(b)(2)(A) ("To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap . . . .") (emphasis added). Viewed in this light, a "delay" must refer consistently to the violation of either the A or B guarantees. "[T]he actual number

of days the issuance of the patent was delayed” therefore refers to each day covered by a “period of delay” in the first clause with no such day counted twice.

This court has also examined the legislative history of the 1999 Act but finds nothing to rescue the PTO’s cause. In the first place, only a “most extraordinary showing of contrary intentions” by Congress justifies a departure from the plain language of a statute. Garcia v. United States, 469 U.S. 70, 75 (1984). Far from intentions contrary to the meaning of section 154(b), the legislative history generally supports the interpretation required by the statutory language itself. The AIPA’s section-by-section analysis states:

Accordingly, subtitle D removes the 10-year caps from the existing provisions, adds a new provision to compensate applicants fully for USPTO-caused administrative delays, and, for good measure, includes a new provision guaranteeing diligent applicants at least a 17-year term by extending the term of any patent not granted within three years of filing. Thus, no patent applicant diligently seeking to obtain a patent will receive a term of less than the 17 years as provided under the pre-GATT standard; in fact, most will receive considerably more.

H.R. Rep. No. 106-464, at 125 (1994) (emphases added). From this, it is apparent that the statutory language should provide a minimum seventeen-year term for most patents. The outcome suggested by the language itself effectuates this goal by ensuring such a minimum term unless the applicant caused delays.

The PTO urges this court to read that passage in view of the 25-month average patent pendency at that time—that is, most patents received more than a seventeen-year term because of the shorter prosecution periods. Even taking that context into account, this court notes that the PTO’s interpretation effectively creates a seventeen-year term cap where B delays are greater than A delays. In other words, any A delay before the three-year mark causes PTO delays in issuance beyond the three-year

mark—thereby violating the B guarantee. Together, these effects, under the PTO’s desire to aggregate A and B delays, reduce the effective term of the patent towards seventeen years. The passage from the House report does not expressly preclude that type of effective cap, but the context suggests a very different goal of supplying adequate protection that will often be “considerably more” than the PTO’s effective cap. In any event, the House report does not produce any “extraordinary showing of contrary intentions.” Moreover, if the Act intended to create a seventeen-year cap, it could have easily done so with just a few words.

The PTO next highlights the belated addition of the B guarantee into section 154(b) for support. Before enactment of AIPA, section 154(b) only provided extensions for the category that now fall under C adjustments. See 35 U.S.C. § 154(b)(1)-(2) (1996). The earlier versions of AIPA added only A delays. See S. 507, 105th Cong., 143 Cong. Rec. S2678, S2696-97 (Mar. 20, 1997). Not long afterwards, B adjustments appeared in drafts of section 154(b). See H.R. 400, 105th Cong., 143 Cong. Rec. H1629, H1651 (April 17, 1997). According to the PTO, this legislative history suggests that Congress did not intend to give patentees already eligible for A adjustments additional compensation where the A delay occurred during the first three years of prosecution. Even if these ambiguous timing observations suggested some kind of substantive difference in the meaning of section 154(b), they would be wholly irrelevant to interpretation of the law itself. Such opaque timing observations hardly amount to a “most extraordinary showing of contrary intentions,” especially when the language of the statute trumpets its meaning by itself. See Harbison, 129 S. Ct. at 1494 (Thomas, J., concurring) (“And Congress’ silence certainly does not empower us to go even farther

and incorporate such an assumption into the text of these provisions.”). In sum, legislative history—always a very dull instrument for extracting the essence of statutory meaning—provides no reason to depart from the language of section 154(b).

Last, the PTO contends that its interpretation is entitled to deference under either Chevron U.S.A., Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837 (1984) or Skidmore v. Swift & Co., 323 U.S. 134 (1944). Because the language of the statute itself controls this case and sets an unambiguous rule for overlapping extensions, this court detects no reason to afford special deference to the PTO’s interpretation. See Smith v. City of Jackson, Miss., 544 U.S. 228, 267 (2005) (quoting Pub. Employees Ret. Sys. of Ohio v. Betts, 492 U.S. 158, 171 (1989)) (“Of course, it is elementary that ‘no deference is due to agency interpretations at odds with the plain language of the statute itself.’”).

#### IV.

This court therefore affirms the judgment of the district court. Section 154(b)’s language is clear, unambiguous, and intolerant of the PTO’s suggested interpretation. For that reason, this court accords no deference to the PTO’s greater-of-A-or-B rubric.

AFFIRMED